

PATENT
733755-6

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: ANTHONY R. ROTHSCHILD

Serial No.: 09/755,541

Filed: January 5, 2001

Title: SYSTEM AND METHOD FOR ADDING
AN ADVERTISEMENT TO A PERSONAL
COMMUNICATION

Art Unit: 3622

Examiner: Carlson, Jeffrey D.

Confirmation No.: 5271

REPLY TO EXAMINER'S ANSWER TO APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is filed pursuant to 37 C.F.R. § 41.41 in response to the Examiner's Answer dated August 20, 2010.

REPLY BRIEF

The Examiner's Answer spends a great deal of time on the issue of whether the Internet advertising system of Roth can be combined with the email advertising system of Gabbard. However, the Answer all but ignores the primary issues on appeal – whether the prior art discloses an advertising application that ***uses content of an email to automatically select an advertisement from a plurality of advertisements, or uses content of an email and advertisement-type data (as provided by a sender of the email) to automatically select an advertisement from a plurality of advertisements.*** As discussed in the Appeal Brief, these features are not disclosed in the prior art.

As the Supreme Court stated in *KSR*, a determination of obviousness is based on "whether the [claimed] improvement is more than a predictable use of prior art elements according to their established function." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007). The Examiner argues in his Answer that Roth discloses an Internet advertising system that uses "keywords" to "target" advertisements for web pages, and that it would have been predictable for one of ordinary skill in the art to incorporate this feature into the email advertising system of Gabbard.

The primary flaw in this argument is that the claimed invention does not use content of an email to "target" advertisements. Instead, in the claimed invention content of an email is used to ***automatically select at least one advertisement*** from a plurality of advertisements, wherein the ***selected advertisement is inserted into the email.*** See, e.g., Claim 62. This feature is not disclosed in Roth. The Examiner conveniently

ignores the claim language, and skirts around the issue by arguing that Roth uses keywords to "target" advertisements. While Roth provides that advertisers can use keywords to bid on advertising space for a web page, keywords are not used in Roth to automatically select and insert an advertisement. Instead, an advertisement is selected and inserted into the web page based on **a highest bid**. Because the prior art does not disclose the feature of using content data to select and insert an advertisement, it does not (and cannot) render the claimed invention obvious.

In the Appeal Brief, the claimed inventions were broken down into two categories: (1) claims directed toward using ***content of an email to automatically select an advertisement*** from a plurality of advertisements and inserting the selected advertisement into the email; and (2) claims directed toward ***using content of an email and advertisement-type data (as provided by a sender of the email) to automatically select an advertisement*** from a plurality of advertisements and inserting the selected advertisement into the email. Appellant shows below that the claimed features of these categories are not disclosed in the prior art. Appellant further shows that even if these features are considered to be disclosed in the prior art references, it still would not have been obvious to combine the Internet advertising system of Roth with the email advertising system of Gabbard.

I. THE PRIOR ART DOES NOT DISCLOSE USING CONTENT OF AN EMAIL TO SELECT AN ADVERTISEMENT FROM A PLURALITY OF ADVERTISEMENTS AND INSERTING THE SELECTED ADVERTISEMENT INTO THE EMAIL

Independent Claim 62 provides an advertising application for "permitting a sender to submit communication data to said Web host and to identify at least one

recipient of said communication data; using at least a portion of the content of said communication data to ***automatically select at least one advertisement*** from said plurality of advertisements; [and] ***inserting said at least one [selected] advertisement*** and said communication data into a personal electronic communication, wherein said personal electronic communication comprises an e-mail message." Claim 62 (emphasis added). Similar features are recited in independent Claims 68, 75, 81, 87 and 92.

The Examiner rejected Claim 62 under 35 U.S.C. § 103(a) as being unpatentable over Gabbard in view of Roth. In doing so, the Examiner acknowledged that Gabbard does not disclose using content of an email to select an advertisement to be inserted into the email. *See, e.g.*, Answer at p. 4 ("Gabbard et al. fails to explicitly teach targeting advertising according to the subject matter or content of the email message/body itself."). The Examiner argued, however, that such a feature is disclosed in Roth. The Appellant respectfully disagrees.

A. Roth does not use content data to select an advertisement from a plurality of advertisements, wherein the selected advertisement is inserted into a web page

The Examiner argued that Roth "teaches that the ad chosen to be shown on that webpage/screen can be ***targeted*** according to several factors including both the demographics of the user and the keywords of the content being read by that user." Answer at pp. 4-5 (emphasis added).

The flaw in this argument is that the advertising application recited in Claim 62 does not "target" anything. Instead, it performs the functions of "using at least a portion of the content of said communication data to ***automatically select at least one***

advertisement from said plurality of advertisements [and] **inserting said at least one [selected] advertisement** ... into a personal electronic communication.” Claim 62 (emphasis added). While the Examiner attempts to generalize Claim 62, by arguing that it merely uses content data to “target” advertisements, such a generalization impermissibly reads limitations out of the claim. This is especially important because these limitations (*i.e.*, using content of an email to automatically select an advertisement from a plurality of advertisements, and inserting the selected advertisement into the email) are not disclosed in the prior art. The Examiner’s meaning of “targeting” is unclear and that term does not appear in any of Appellant’s claims.

Roth provides an Internet advertising system, in which advertisements for web pages are auctioned off to the highest bidder. See Abstract. As shown in Figure 3, a client browser (*e.g.*, Netscape™, Internet Explorer™, etc.) (11) is used to view a web page from a website (14). If the web page includes an HTML reference to a web server (310), then the web server (310) provides an advertisement to the client browser (11). See, *e.g.*, col. 6, ll. 41-45. In doing so, the web server (310) selects an advertisement from ad tables (16A) based on a highest bid received from a plurality of bidding agents (30A, 30B, 30Z). See, *e.g.*, col. 7, ll. 19-23.

Thus, Roth does not use keywords to “automatically select” an advertisement from a plurality of advertisements, wherein the selected advertisement is inserted into a web page. Instead, Roth provides an Internet advertising system in which advertisements for web pages are **automatically selected based on a highest bidder**. See, *e.g.*, col. 2, ll. 54-65 (“Next, the bid selection logic selects the highest bid from the various available bids and the advertisement which is specified in the highest bid is

displayed."); and col. 7, ll. 19-23 ("After receiving input from bidding agents 30 (that is from all the bidding agents 30 that submits bids) the bid selection logic 16C in view server 320 selects the highest bid and indicates to web server 310 which advertisement should be displayed in response to the view-op.").

While Roth provides that "keywords" can be used, they are only used by the bidding agents to bid on advertising space. See, e.g., col. 10, ll. 33-67 and col. 11, ll. 33-37. In other words, in response to receiving an HTML reference, the view server (see Fig. 3, ref. 320) submits data to a plurality of bidding agents (30A, 30B, 30Z), including viewer data (e.g., name, email, IP info., etc.) and web page data (e.g., owner, URL, keywords, etc.) (see col. 10, l. 33 - col. 11, l. 20). The bidding agents (30A, 30B, 30Z) use this data to bid on advertising space associated with the HTML reference. See, e.g., col. 11, ll. 33-37. Thus, while keywords are one of various criteria provided to advertisers, they are only used to identify "words that must be in the site if a bid is to be submitted." See col. 14, ll. 21-22. The keywords, however, are not used by the bid selection logic (16C) to automatically select an advertisement for insertion in the web page. Instead, that selection is based **exclusively on the highest bid**. See, e.g., col. 2, ll. 54-65; and col. 7, ll. 19-23.

While the Examiner acknowledges that Roth functions in this manner (see Answer at pp. 6-7 ("[t]he ad selection process includes collecting bids")), he nonetheless argues that "Applicant's open-ended claims do not preclude the presence of bidding as part of the ad selection process." This argument is without merit. Claim 62 recites "using at least a portion of the content ... to automatically select at least one advertisement." Thus, according to Claim 62, content of an email must be used to

automatically select an advertisement. While this does not preclude using additional information to select an advertisement, it requires at a minimum that content data be used in the automatic selection process.

In Roth, content data is not used to automatically select an advertisement from a plurality of advertisements. Instead, it is used (at best) to identify a subset of advertisers that are interested in advertising on a particular web page. The advertisement that is ultimately inserted into the web page is selected based on a highest bid. See, e.g., col. 2, ll. 54-65; and col. 7, ll. 19-23. In other words, ***Roth does not use content data to automatically select one-from-many, wherein the selected one is inserted into a web page.*** Instead, the selection process of one-from-many is based exclusively on a highest bid. This is true regardless of whether there are one, two or one hundred interested advertisers. Thus, the cited prior art does not disclose an advertising application that uses content of an email to automatically select an advertisement from a plurality of advertisements and insert the selected advertisement into the email.

B. It would not have been obvious to combine the Internet advertising system of Roth with the email advertising system of Gabbard

Even if the “content data” feature had been disclosed in Roth, which is not the case, one of ordinary skill in the art would not have been motivated to combine the Internet advertising system of Roth with the email advertising system of Gabbard. This is because the two references are directed toward different technologies. As discussed in the Appeal Brief, Gabbard provides a system for inserting an advertisement into an

email, which is a ***private communication***, wherein Roth provides a system for advertising on a ***web page***, which is ***publicly accessible***.

In the Answer, the Examiner states that "Gabbard et al. teaches that his advertisement-enhanced emails can be accomplished as web mail – which is a web-based email client that displays email messages as *web pages*." Answer at p. 8 (emphasis in original); see also *id.* at p. 9 ("it is noted that Gabbard et al's emails can be represented by web pages where the emails are provided as part of a 'web mail' application."). This does not, however, address the question of whether an advertising system that relies on publicly available information (like the Roth system) can be used in an email environment. In other words, while Gabbard provides that a web site can be used to display emails, and that an email advertising system can function in a web site environment, that does not mean that the opposite is true, *i.e.*, that a web site can be displayed in an email, and that a web site advertising system can function in an email environment. As described in the Appeal Brief (see Corrected Appeal Brief at pages 23-27), the Internet advertising system of Roth requires the use of publicly available information (e.g., publicly available keywords, etc.), and such information is not available in an email advertising system.

Another reason why it would not have been obvious to combine Roth with Gabbard is because there is no disclosure in Roth on how the Roth system could be used in an email environment without violating the Electronic Communications Privacy Act of 1986 ("ECPA"), which "makes it an offense to 'intentionally intercept[], endeavor [] to intercept, or procure[] any other person to intercept or endeavor to intercept, any wire, oral, or electronic communication.'" Corrected Appeal Brief at pp. 27-28 (citing

U.S. v. Councilman, 418 F.3d 67, 72 (1st Cir. 2005)). In his Answer, the Examiner stated that he "is not aware that determinations of obviousness must also be weighed in view of privacy policies," and therefore "the examiner is not concerning himself with violations or non-violations of privacy policies." Answer at p. 9.

The issue of obviousness, however, is not decided in a vacuum. Instead, it is decided by one of ordinary skill in the art. See, e.g., *KSR Int'l*, 550 U.S. at 417. Appellant's position is that it would not have been obvious to combine Roth with Gabbard because one of ordinary skill in the art would not be motivated to develop an illegal advertising system. Thus, privacy laws are necessarily relevant to the issue of obviousness. While Appellant appreciates the Examiner's candor that he "is not concerning himself with violations or non-violations of privacy policies" (see Answer at p. 9), privacy laws and the prevailing criminal justice codes (federal and state) would be taken into consideration by those skilled in the art, and are therefore relevant to the issue of obviousness.

Finally, Appellant argued that it would not have been obvious to combine Roth with Gabbard because there is no disclosure in Roth on how such a system, which relies on publicly available information (like keywords), could function in an email environment. As discussed in the Appeal Brief, it is common knowledge that web page information is provided in a data set referred to as "meta-data," or "meta-tags." Meta-data is data that is (1) created by the owner of the web page, (2) associated with the web page, and (3) includes information on the web page (e.g., URL, keywords, etc.). See Corrected Appeal Brief at pp. 17-19 (citing *Horphag Research Ltd. v. Garcia*, 475 F.3d 1029, 1033 (9th Cir. 2007)). Thus, it is relatively easy for Roth to function in a web

page environment. It only needs to collect predefined web page information. Emails, on the other hand, do not generally include meta-data. To the extent they do, they most certainly do not include meta-data on "keywords," or "content meta-data." In order for Roth to function in an email environment, it would have to (1) intercept an email, (2) search for terms in the email, and (3) identify terms that are relevant – none of which are disclosed in Roth.

In the Answer, the Examiner devotes a large portion of the discussion on the issue of whether Roth acquires keywords before a view-op presents itself, or in real time (*i.e.*, after a view-op presents itself). The Examiner concludes that "Roth et al. uses freshly-retrieved data as part of the content-based advertisement selection." Answer at p. 10. While Appellant respectfully disagrees, the issue is not so much as to **when** keywords are acquired, but **how** keywords are acquired.

While there is evidence in the record that shows that it was commonplace to acquire web page information (*e.g.*, URLs, keywords, etc.) from web page meta-data, there is no evidence in the record that shows that meta-data could be used to acquire keywords for an email. In fact, the Examiner agrees that Roth does not teach how email information would be collected. See Answer at pp. 11-12 ("Roth et al. does not appear to explicitly state examples of how (at the time of the view-op) he determines keywords for a page."); see also *id.* at p. 11 ("Applicant argues that Roth et al fails to teach how email information would be collected. Indeed Roth et al doesn't ...").

The Examiner argues that because Roth does not teach how an Internet advertising system could function in an email environment, "we turn to one of ordinary skill who was tasked by Gabbard et al with considering 'other (targeting) criteria.'" *Id.* at

p. 11. The Examiner then states that he "**believes** one of ordinary [skill] would indeed understand that a parsing technique to locate frequently occurring words would be one example." Answer at p. 12 (emphasis added).

First, what the Examiner "believes" is not proper support for a rejection. In essence, the Examiner is taking Official Notice that such a "parsing technique" was commonly used in 1999 to identify keywords on websites. It is improper, however, to rely on Official Notice when, as here, the Appellant has "adequately traversed the examiner's assertion of official notice." See M.P.E.P. § 2144.03(A) ("It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well know are not capable of instant and unquestionable demonstration as being well-known."); and § 2144.03(C) ("If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office Action if the rejection is to be maintained.").

Second, the Examiner does not explain how a "parsing technique" could be used by an Internet advertising system to retrieve keywords from private communications. The Examiner argues that because Roth has access to publicly available website information, and because email systems can be web-based, Roth could function in an email environment. See, e.g., Answer at p. 8. The flaw with this argument is that while an email system may be web-based, the emails that are stored on that system are not publicly available. Instead they remain **private communications** that can only be accessed by someone with the **correct user name and password**. Thus, while Roth may be able to access information **about** the web-based email system (e.g., website

meta-data, etc.), it cannot access the private emails themselves, and therefore would not be able to function in an email environment. In other words, Roth cannot parse that which it does not have access to.

Finally, there is no evidence that "parsing techniques" were used in 1999 to identify keywords on websites. In Roth, the advertising system is only in communication with the web browser, and is not in communication with the website. See Figure 3. This is important because an advertising system could not "parse" (or spider) a website for keywords if it did not have access to that website. In fact, even the Examiner agrees that "[n]owhere in Roth et al. is it stated that web sites are spidered ahead-of-time." Answer at p. 10. Instead, the Examiner argues that the keywords provided to the bidding agents are "freshly retrieved." *Id.* Such an argument, however, further supports Appellant's position that, in Roth, keywords are retrieved from meta-data, *i.e.*, a technique that is not applicable to emails..

Roth provides that "[t]he present invention begins to function when the web page which is accessed by browser 11 contains a conventional Internet HTML reference to web server 310." Col. 6, ll. 41-45. According to Roth, the "HTML reference" is then provided to the view server (320) via the web server (310). Col. 7, ll. 10-17. The Examiner appears to be arguing that it is this "HTML reference" that includes the "freshly retrieved" keywords. See Answer at p. 10. If this were true, then it would be impossible for Roth to parse (or spider) keywords from the website. This is because an HTML reference (by definition) does not include the entire website. Instead, it is only a "reference" to the website, and as such only includes data **about** the website (*e.g.*, website meta-data). Thus, if keywords in Roth are being retrieved in real-time, then

they must be retrieved from the meta-data as provided in the HTML reference.

The Examiner's only argument as to how Roth could function in an email environment is that he "believes one of ordinary [skill] would indeed understand that a parsing technique [could be used] to locate frequently occurring words." Answer at p. 12. Not only does the Examiner not cite any support for this "belief," but he admits that his primary reference (*i.e.*, Roth) does not disclose this feature. See Answer at p. 10 ("Nowhere in Roth et al is it stated that web sites are spidered ahead-of-time with keywords for the sites being stored in a database."). The Examiner cannot have it both ways. If the "parsing technique" identified by the Examiner is a common way to identify keywords on web pages, then why isn't it disclosed in Roth? And if it isn't disclosed in Roth, then what evidence is there that this technique was commonly used in 1999 to identify keywords on web pages? The simple answer is NONE. There is **no evidence** in the record that it was commonplace in 1999 to use a parsing technique to identify keywords on web pages. While there is ample evidence to show that it was commonplace in 1999 to use meta-data to identify keywords on web pages, (see Corrected Appeal Brief at pp. 26-27), there is no evidence that such a technique was (or could have been) used in 1999 to identify keywords on emails. *Id.* For at least this reason, the current ground of rejection is improper, and should therefore be reversed.

The Examiner's obviousness argument stems from a statement in Gabbard that "[a]lthough only two types of advertisement selection criteria have been discussed [*i.e.*, demographics and exposure requirements], it should be understood that other criteria can be used without departing from the spirit of the present invention." Col. 10, ll. 20-26. Such a statement, however, does not mean that any and all criteria is obvious.

Instead, it means that other criteria, like "color and design," could also be used in the selection process. See, e.g., col. 10, ll. 20-26.

At best, this statement provides motivation to modify Gabbard to utilize other known advertising selection criteria. Thus, the combination of Gabbard and Roth would (at best) yield an advertising system that selects an advertisement based on demographics and exposure requirements (as provided in Gabbard) and a highest bid (as provided in Roth). Any argument that additional criteria (e.g., content of an email, etc.) is obvious over the prior art is based on impermissible hindsight. See, e.g., *KRS, Int'l*, 550 U.S. at 421 ("A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning."); and *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 1553 (Fed. Cir. 1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.").

Accordingly, the rejection of independent Claim 62, and the rejections of independent Claims 68, 75, 81, 87 and 92, which include similar limitations, should be withdrawn. Further, the rejections of Claims 65, 69, 70, 73, 76, 77, 84, 86, 89, 90, 94 and 95, which depend therefrom, should also be withdrawn.

II. THE PRIOR ART DOES NOT DISCLOSE USING CONTENT OF AN EMAIL AND ADVERTISEMENT-TYPE DATA TO SELECT AN ADVERTISEMENT FROM A PLURALITY OF ADVERTISEMENTS AND INSERTING THE SELECTED ADVERTISEMENT INTO THE EMAIL

Dependent Claim 88 recites that the advertising application further provides the functions of ***“allowing a sender to select a type of advertisement that can be included in said personal communication by submitting advertisement-type data, said sender-provided data further comprising said advertisement-type data; and using said at least a portion of said communication data and said advertisement-type data to select said at least one of said plurality of advertisements.”*** Claim 88 (emphasis added). Similar limitations are recited in dependent Claim 93.

The Examiner argues that “user profile data (such as demographic information) by the user to the system is taken to address the limitation of providing advertisement-type data, as this profile information is a basis for the type of advertisement selected according to that user-provided information.” Answer at p. 6. The Appellant respectfully disagrees.

First, it is not sufficient for a “user,” which may include a recipient, to provide advertisement-type data. According to Claim 88, this data must be provided by “a sender” of the email. This is important in that it allows the sender to control (to at least a certain degree) the type of advertisement that is included in the email. The inclusion of an inappropriate advertisement (e.g., inserting an advertisement for McDonalds™ into an email sent to a Hindu) can reflect poorly on the sender, and may spoil his/her relationship with the recipient. Thus, it is advantageous for the sender to be involved in the advertisement selection process. While the Examiner attempts to generalize Claim

88 by arguing that the advertisement-type data can be provided by “a user,” such a generalization is improper in that it impermissibly reads a limitation out of the claim, *i.e.*, ***that it is “the sender” who provides the advertisement-type data.***

Second, the “user profile data” disclosed in Gabbard is not provided by the sender of the email, but by the recipient. According to Gabbard “advertisements may be selected ... based on available demographic information,” and “acquisition of demographic information is required before the e-mail account is provided to a user.” See col. 10, ll. 3-10. In other words, before an email account is provided to a recipient, he/she must first provide demographic data. It is this recipient-provided demographic data that is used in the advertisement selection process. Thus, to the extent that it can be argued that “demographic data” is the same as “advertisement-type data,” such data is not provided by the sender, as claimed, but by the recipient.

Finally, Claim 88 provides “allowing a sender to select a type of advertisement that can be included in said personal communication by submitting advertisement-type data.” It is inaccurate for the Examiner to assert that “demographic data” is the same as “advertisement-type data.” Demographic data is, by definition, data on statistical characteristics of the population (*e.g.*, age, race, gender, etc.). Demographic data does not identify a type (or category) of advertisement, and is therefore not “advertisement-type data.”

In response, the Examiner argued that “[a]ny data provided by a user that is used as a basis to select an advertisement qualifies as ‘advertisement-type data.’” Answer at p. 13. The Appellant respectfully disagrees. As discussed above, Claim 88 requires that the advertisement-type data be submitted by “a sender,” not merely by “a user.”

Also, while "demographic information" may be used in Gabbard to select an advertisement, such data is not submitted by the sender of the email, and therefore does not disclose the "advertisement-type data" limitation of Claim 88.

The Examiner also argues that "the claimed embodiments are directed to a different embodiment where the advertising application selects the advertisement; [in Claim 88] the user is not believed to be selecting a particular advertisement." Answer at p. 13. The Appellant respectfully disagrees. Claim 88 provides that advertisement-type data is used (together with other information) to select an advertisement from a plurality of advertisements, and that the advertisement-type data is provided by "a sender" of the email. Thus, contrary to the Examiner's argument, the sender participates in or influences the selection of an advertisement by submitting advertisements-type data.

Because Gabbard fails to disclose data that is both (i) provided by a sender of the email and (ii) used (at least in part) to select an advertisement from a plurality of advertisements, wherein the selected advertisement is inserted into the email, the rejection of Claim 88, and the rejection of Claim 93, which includes similar limitations, should be withdrawn.

III. CONCLUSION

Appellant respectfully requests the reversal of the rejections of currently pending Claims 62, 65, 68-70, 73, 75-77, 81, 84, 86-90 and 92-95 and allowance of these claims forthwith, for the reasons set forth above and in the Appeal Brief.

Serial No. 09/755,541
October 20, 2010
Page 18

IV. FEES

The Commissioner is authorized to charge \$270 for Filing a Reply Brief, pursuant to 37 C.F.R. § 41.20(b)(2), and any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0639.

Respectfully submitted,

Date: October 20, 2010



Todd E. Fitzsimmons
Attorney for Appellant
Registration No. 44,683

O'MELVENY & MYERS LLP
400 South Hope Street
Los Angeles, CA 90071-2899
Telephone: (213) 430-6000
Facsimile: (213) 430-6407
Email: tfitzsimmons@omm.com